REMARKS

Claims 1 – 7 and 9 – 24 stand rejected under 35 U.S.C. §112, ¶2; Claims 1 – 7, 9 – 11, 13 – 19, 23, and 24 stand rejected under 35 U.S.C. §102(e) as anticipated by Pub. No. US 2001/0116241 ("Lai"); and Claims 12 and 20 – 22 stand rejected under 35 U.S.C. §103(a) as unpatentable over Lai.

1. Finality of Office Action

Applicant respectfully requests that the finality of the Office Action mailed June 2, 2003 (paper no. 9) be withdrawn. An Office Action is not properly made final where "the examiner introduces a new ground of rejection that is [not] necessitated by applicant's amendment of the claims." MPEP 706.07(a). In this instance, rather than being necessitated by Applicant's amendment, the new ground of rejection is based on a completely contradictory reading of the principal cited reference than was presented in the first Office Action (paper no. 6). In particular, the Office has taken diametrically opposed positions in characterizing the disclosures of Lai. In the first Office Action, the Office took the position that Lai "fails to recite that the provider (agent having web site 12) is affiliated with a plurality of offices" (First Office Action, p. 3). The Office now takes the completely the opposite position that "Lai teaches that the provider computer ("agent's company website 12") is affiliated with a plurality of provider offices (merchant websites 125 …)" (Final Office Action, p. 2). While Applicant is willing to address the merits of this abrupt change in position by the Office, it is unfairly punitive to Applicant to limit the avenues available for addressing such merits by making the second Office Action final ("The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity," MPEP 706).

Applicant further notes that the final Office Action is even internally inconsistent in its characterization Lai. While the prior-art rejections rely on identifying a correlation between the "provider offices" recited in the claims and merchant websites 125 disclosed in Lai,

the §112 rejections rely on the exact opposite, namely that "the [provider] offices are *not* devices which are in communication with the [provider] computer" (Final Office Action, p. 4, emphasis added). In the interest of advancing prosecution, Applicant responds as best able to both the §112 and prior-art rejections, but believes that the Final Office Action as a whole is improper because of its inconsistent characterization of the only reference on which it relies.

2. Rejections Under 35 U.S.C. §112

All pending claims stand rejected under 35 U.S.C. §112, ¶2 because "[i]t is unclear how the provider computer (a computing device) may be affiliated with a plurality of (provider) offices" (Final Office, p. 4, emphasis in original). Claim 1 has been amended to clarify that it is the provider itself that is affiliated with the plurality of provider offices, with the provider computer being operated for the provider (*see, e.g.,* Application, Fig. 1A and Claims 13 and 23). It is believed that such an affiliation between the provider and the provider offices is well-defined, particularly in view of the definition provided in the specification of a provider "office" (Application, p. 4, ll. 28 – 30). The rejections of independent Claims 13 and 23, and the claims that depend therefrom, are thus traversed because those claims already recited that it was the provider affiliated with the plurality of provider offices, rather than the provider computer.

In view of this clarification, it is believed that the Office Action's proposed interpretation of the claims, i.e. simply to ignore the limitations requiring affiliation with the provider offices and of requiring recordation of collection of the cost from the customer at one of the provider offices, is incorrect. These limitations are now well defined to limit the scope of the claims by requiring a certain affiliation that limits the manner in which steps recited in the claims may be performed. Indeed, as explained further in discussing the prior-art rejections, such limitations on the manner in which such steps may be performed are relevant to comparisons with the prior art.

3. Prior-art Rejections

All pending claims stand rejected either as anticipated or as obvious over Lai. These rejections are respectfully traversed.

These prior-art rejections are based on the Office Action's assertion that

> [s]ince, the purchases are made at the merchant websites, it is inherent that [the] provider computer (agent's company web site 12) records the collection of cost from the customer at one of the plurality of provider offices in accordance with the communication relating to the transaction (refer to transaction as discussed in para [0036]).
> (Final Office Action, pp. 2 – 3).

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference." MPEP 2112, *citing In re Robertson*, 49 USPQ2d 1949, 1950 – 51 (Fed. Cir. 1999). In this instance, not only is the Office Action's suggested mode of operation not necessarily present in Lai, there is a specific teaching in Lai that is contrary to the claim limitations. In particular, the Office Action draws a correspondence between the "provider computer" recited in the claims and the "agent's company website 12" described in Lai, and between the "provider offices" recited in the claims and the "merchant websites 125" described in Lai. While the Office Action asserts that it is inherent that the agent company web site record collection of cost from the customer at one of the merchant websites, Lai itself actually describes something very different:

> The consumer selects an item from the merchant website and clicks on the company button option to select payment using the services of the company agent. The consumer then submits his PIN 126 to the merchant website 125.... The merchant website 125 then forwards transaction information 127 ... to the agent's company website 12. <u>The company website</u> 12 then validates the transaction.... <u>The agent's website</u> then contacts an Automatic Clearing House (ACH) ..., sending a transfer request 129 for making an escrow payment 130 from the member's bank account 132 or credit account 134 to an escrow account 136 that is maintained by the clearing house 128.... The clearing house then sends a transfer acknowledgment 138 <u>to the agent as represented by the company website</u> 12.... If the transaction is validated, the agent's company website 12 sends an authorization 142 giving an authorization number and the member's address to the merchant website 125. The merchant then begins to process the order.
> (Lai, ¶36, emphasis added).

Thus, the description provided by Lai of how a transaction is executed shows that collection of cost is performed *not* by the merchant website as the Office Action asserts, but instead by the agent's company website. Indeed, a particular preoccupation of Lai is the need to *avoid* having the cost collected by the merchant website because of potential security breaches (*see* Lai, ¶¶ 4 – 6). Even with the correspondence suggested in the Office Action, Lai *expressly* discloses managing a transaction in a manner different from what the Office Action suggests. It is axiomatic that there can consequently be no inherent disclosure of the claim limitation in Lai.

Some of the benefits that derive from this difference between Lai and what is claimed were discussed at some length in the response to the first Office Action, and are summarized again here for completeness. Namely, Lai recognizes the desirability to avoid disclosure of certain financial information to internet merchants, but provides a solution that still requires disclosure of that financial information, albeit to an intermediary. In marked contrast, the claimed embodiments permit transactions to be executed without *any* disclosure of financial information by a customer (*see* Application, p. 5, ll. 15 – 19) — the transaction could even be executed in cash if the customer desired. Alternatively, the disclosure of financial information in the form of providing credit-card, bank-account, or similar information could be done in person by the customer so that it need never be routed over a public network like the internet (*see id.*, p. 8, ll. 18 – 21). These abilities derive in part from the affiliation of the provider with a plurality of provider offices at which the cost may be collected (*see id.*, p. 8, ll. 18 – 21), a limitation that is recited in the claims but which is neither taught nor suggested by the cited art.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is urged.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

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